

SECTION III—REMARKS

This amendment is submitted in response to the Final Office Action mailed November 30, 2004, which action the Examiner made final. Claims 14-25 remain pending in the application. Applicants respectfully request allowance of all pending claims in view of the following remarks.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 14-15, 19, 23 and 24 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,919,548 to Barron *et al.* ("Barron"). Applicants respectfully traverse the Examiner's rejections. A claim is anticipated only if each and every element, as set forth in the claim, is found in a single prior-art reference. MPEP § 2131; *Verdegaal Bros. v. Union Oil of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). As explained below, Barron cannot anticipate these claims because it does not disclose every element and limitation recited therein.

Claim 14 recites a process combination for forming a micro electromechanical (MEMS) package including providing "a semiconductor device including an active surface," providing "a conveyance with at least one embedded MEMS device disposed therein," and "disposing the conveyance over the semiconductor device, wherein the at least one embedded MEMS device communicates electrically to the semiconductor device." Barron does not disclose, teach or suggest a process including these limitations. Instead, what Barron discloses is a method for micromachining sacrificial layers of a MEMS system formed in a cavity in a substrate. As shown in Figure 3a-3r, a MEMS device 200 is embedded in a cavity 12 formed in a substrate 10.

What the Examiner has identified in Barron as a semiconductor device 10 is merely a semiconductor substrate (col. 6, line 59-60) that, with nothing else, cannot be considered a semiconductor device. The Examiner argues that because the element 12 of the present application "appears to be" a substrate, the substrate 10 of Barron meets the recited limitation of a semiconductor device. There are two problems with this line of reasoning: first, the Examiner must examine the claims, not the drawings. What element 12 "appear to be" in the drawings is immaterial; the claim recites "a semiconductor device including an active surface" and, consistent with the claim, element 12 is clearly defined in the text as a semiconductor device (*see, e.g.*, page 8, line 9). The Examiner must therefore treat it as such. Second, even if the characterization of element 12 as a substrate were correct—which Applicants do not concede—this line of reasoning would amount to reading limitations from the specification into the claims, which is prohibited. Similarly, what the Examiner identified as a conveyance 24 is not a conveyance. Barron clearly

indicates that element 24 is a *sacrificial layer* (col. 8, lines 1-5), meaning that it is later removed (see Fig. 3r). Since element 24 is a sacrificial layer, it therefore cannot be "a conveyance with at least one embedded MEMS device disposed therein." For the above reasons, Applicants submit that Barron therefore cannot anticipate the claim, and respectfully request withdrawal of the rejection and allowance of the claim.

Regarding claims 15 and 19, if an independent claim is allowable, then any claim depending therefrom is also allowable. *See generally* MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 14 is in condition for allowance. Applicants respectfully submit that claims 15 and 19 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

Claim 23 recites a process combination including providing a semiconductor device, "accommodating a detached micro electromechanical structure (MEMS) device upon the semiconductor device," providing a conveyance "over the semiconductor device and around the detached MEMS device," and contacting encapsulation material with at least one of the semiconductor device, the detached MEMS device, and the conveyance to form an integrated MEMS package. By analogy to the discussion above for claim 14, Barron cannot disclose every element and limitation of this claim. Applicants submit that Barron therefore cannot anticipate the claim, and respectfully request withdrawal of the rejection and allowance of the claim.

Regarding claim 24, if an independent claim is allowable, then any claim depending therefrom is also allowable. *See generally* MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 23 is in condition for allowance. Applicants respectfully submit that claim 24 is therefore allowable by virtue of its dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of the claim.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 18 and 25 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, Barron. Applicant respectfully traverses the Examiner's rejections. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claims 14 and 23 are in condition for allowance. Applicant therefore respectfully submits

that claims 18 and 25 are allowable by virtue of their dependence on allowable independent claims, as well as by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.


Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 1-31-05


Todd M. Becker
Attorney for Applicant(s)
Registration No. 43,487

Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles CA 90025-1030
Phone: 206-292-8600
Facsimile: 206-292-8606

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